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Rader Fishman & Grauer PLLC
Suite 140
39533 Woodward Avenue
Bloomfield Hills, MI 48304

EXAMINER
HEWITT II, CALVIN L

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/990,911
Filing Date: November 14, 2001
Appellant(s): BLY ET AL.

Michael B. Stewart, Reg. No. 36,018 and Charles A. Bienman, Reg. No. 51,472
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 15 August 2006 appealing from the

Office action mailed 17 December 2004.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,067,525	JOHNSON et al.	5-2000
6,236,990	GELLER et al.	5-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claims 12, 17 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12, 17 and 22 are dedicated to a system, however they recite

limitations that occur outside the system, in particular a "manual check".

Claim Rejections - 35 USC § 103

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Johnson et al., U.S. Patent No. 6,067,525 and Geller et al., U.S. Patent No.

6,236,990.

As per claims 1-23, Johnson et al. teach a system for disposing products

comprising: an asset database (figures 4, 10A, B, 12 and 14-15B), a set of pre-

defined conditions related to a recommendation of asset disposition based on

information (associated with a plurality of assets) stored in said system (figures

10A-B; column/line 13/65-16/39), and providing disposition options (figures 21A-

B; column/line 15/1-16/39). Johnson et al. provide a general teaching for

developing a user-specific financing solution (e.g. leasing option) based on a

desired asset and user specifications (figures 10A-B, 14-16, 21A-B; column/line

13/64-14/58, column/line 15/4-16/39). The terms such as option-to-buy, lease

renewal, asset return, leasing of other assets, lease documents, lease term,

asset usage as defined by lease agreement, maintenance history, etc. are well

known to those of ordinary skill in providing assets for sale, rent and/or lease,

and hence it would have been obvious to one of ordinary skill to incorporate said

terminology when seeking to provide user's with various leasing options (column

15, lines 50-56). Johnson et al. also teach asset delivery (figure 21E; column/line

17/58-18/36). Specifically, the system of Johnson et al. is dedicated to providing

users with various financing and leasing options based on data stored in

customer, quotation, product, configuration and finance modules such as

product, user, and other financing data (column 9, lines 46-54; column/line 11/64-

12/12; column 12, lines 22-57; column 13, lines 5-23 and 35-51; column 14, lines

22-55; column 15, lines 17-40). However, according to the Applicant's system

this data (e.g. asset return, make/model, etc.) is non-functional data as

descriptive material cannot render nonobvious an invention that would have

otherwise been obvious (*In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404

(Fed. Cir. 1983) (when descriptive material is not functionally related to the

substrate, the descriptive material will not distinguish the invention from the prior

art in terms of patentability)). The MPEP (2106 section V, B, 2) states that a

computer that differs from the prior art solely with respect to nonfunctional

descriptive material that cannot alter how the machine functions (i.e., the

descriptive material does not reconfigure the computer). Claims 12, 17 and 22

recite additional non-functional data as they refer to steps/process/features that

occur outside the system (i.e. a manual check). However, Johnson et al. do not

provide a hierarchy of options. Geller et al. teach a ranking system that allows a

user to rank products based on user specifications and to adjust said

specifications to further analyze said products (abstract). Therefore, it would

have been obvious to one of ordinary skill to combine the teachings of Johnson

et al., and Geller et al. in order to effectively to present disposition options to a

user ('525, column 16, lines 20-40; '990, abstract)

(10) Response to Argument

CHART MAPPING THE PRIOR ART OF JOHNSON et al. and GELLER et al.

TO APPLICANT'S BROADEST CLAIM

Assets-Products (Johnson et al.)

Asset User-Customer purchasing or leasing the product

Predefined Conditions-Time and cost variables

Conditions being met-In order to produce a product, price quote and financial
plan (i.e. the result of the conditions being met) to meet a
customer's expressed product and financial needs the
Johnson et al. system matches (i.e. meeting of the
conditions) those needs against time and cost variables
(i.e. conditions)

	Claim 1	Johnson et al. US 6067525 and Geller et al. US 6236990
1	At least one database configured to store information associated with a plurality of assets	"Product Information" and "Configuration" databases-Johnson et al. Figure 10A, items 1016 and 1017
2	A set of **pre-defined conditions** related to a recommendation of asset disposition based on an **automated analysis of said information** within said system, at least one of said conditions being met	"**Product Information**" and "Configuration" databases-Johnson et al., Figure 10A, items 1016 and 1017

"Access/Generate Customer Information", "Tag features, benefits competitive information with product module", "Generate customer solution with configurator module", "**Prepare quote, finance and other information with respective modules**"- Johnson et al., Figure 16, items S101-104

Component-"Time with customer", Event d)- "Salesperson **verifies** the accuracy and **applicability of the solution** with business requirements and **customer requirements**", Event e)-"Salesperson **calculates a total cost of the solution for the customer based on quantity, discounts, taxes, programs, etc.**", Event f) "Salesperson **identifies purchasing and financing options for the product(s) offered** to the customer"- Johnson et al., Figure 21B

"The quotation module 408 facilitates calculation and preparation of a bottom line quotation, thus enabling the salesperson to provide the customers immediate and accurate quotes for one or more units. Unit price, quantity, tradein value, discounts, fees, and taxes are all taken into consideration in order to present an accurate and consistent quote." Johnson et al. column 14, lines 21-27

"The quotation module 408 automatically provides **defaults, parameters and tax formulas** which can be established using a tool box in the system administration subsystem 205, to prompt for specific information required to accurately and consistently calculate a quotation."--Johnson et al. column 14, lines 30-35

"The finance module 410 may be used to assist the |

salesperson to edit the amount financed variables including **price, net trade value, cash down requirements, insurances fees**, etc. The salesperson may also be able to edit finance parameter variables such as **interest rates, payment schedule dates, payment frequency, payment method, terms and options. The various payment method alternatives include standard, irregular, blended rate,** variable rate, skip, accelerated, step rent and fixed principal."- Johnson et al. column 15, lines 41-50

"A life cycle cost module 416 is provided to prepare a comprehensive analysis of the cost associated with **utilizing a product over a time period**. The analysis may include a comparison to an existing product, competitor's product, or the same product financed differently. The product analysis may incorporate both **fixed and variable costs** to **demonstrate to the customer the overall impact of a purchase decision including owning costs, operating costs, maintenance costs and depreciation.** Graphic presentations of the results may be generated to **display side-by-side competitive analysis of cash flow and annual savings.** As with the other modules, this module is fully integrated to the rest of the system for intelligent interaction via the event manager 201A." Johnson et al., column 16, lines 8-20

"The **finance module 410 may include the ability to select from preset plans, calculate and customize plans, compare various plans, solve for financial goals** and print reports and forms."- Johnson et al. column 15, lines 21-28

"At step S103, the **configuration module** 406 of the time with customer component 104 is used to create a customer solution. As described above the **configuration** may **previously have been created** and the **information residing therein** may **automatically be used at this step to generate a customer proposal.**"- Johnson et al., Column 28, lines 19-24

	Component-"Time with customer", Event d)- "Salesperson **verifies** the accuracy and **applicability of the solution** with business requirements and **customer requirements**", Event e)-"Salesperson **calculates a total cost of the solution for the customer based on quantity, discounts, taxes, programs, etc.**", Event f) "Salesperson **identifies purchasing and financing options for the product(s) offered** to the customer"- Johnson et al., Figure 21B
3 ... disposition options generated by said system based on said at least one of said conditions, wherein said conditions and said options are chosen to reduce expense by maximizing return on investment to the asset user	"The finance module 410 may be comprised of multiple engines provided to assist the salesperson in quickly calculating and **presenting finance and lease alternatives to customers based on information collected from other modules. The finance module 410 may include the ability to select from preset plans, calculate and customize plans, compare various plans, solve for financial goals** and print reports and forms."-Johnson et al. column 15, lines 17-28

"The quotation module 408 automatically provides **defaults, parameters and tax formulas** which can be established using a tool box in the system administration subsystem 205, **to prompt for specific information required to accurately and consistently calculate a quotation.**"-
-Johnson et al. column 14, lines 30-35

"The system allows the salesperson to edit the amount leased variables including **capitalized costs, acquisition fees, insurance fees, lease rates**, payment factors, payment schedules, payment methods, **security deposits, and taxes and fees** to present various lease options"-column 15, lines 50-57

"A life cycle cost module 416 is provided to prepare a comprehensive analysis of the cost associated with utilizing a product over a time period. The analysis may include a comparison to an existing product, competitor's product, or the same product financed differently. The product analysis may incorporate both **fixed and variable costs** to **demonstrate to the customer the overall impact of a purchase decision including owning costs,** |

| | | operating costs, maintenance costs and depreciation. Graphic presentations of the results may be generated to display side-by-side competitive analysis of cash flow and annual savings. As with the other modules, this module is fully integrated to the rest of the system for intelligent interaction via the event manager 201A." Johnson et al., column 16, lines 8-20

Explanation- "reduce expense by maximizing return on investment to the asset user" is a financial goal of a customer or asset user, hence as Johnson et al. is directed to presenting disposition plans such as financing or lease alternatives to solve financial goals, Johnson et al. teach or least suggests to one of ordinary skill "reduce expense by maximizing return on investment" |
| 4 | [An] hierarchy of disposition options... | Event f) "Salesperson identifies purchasing and financing options for the product(s) offered to the customer"- Johnson et al., Figure 21B

"The finance module 410 may be comprised of multiple engines provided to assist the salesperson in quickly calculating and presenting finance and lease alternatives to customers based on information collected from other modules. The finance module 410 may include the ability to select from preset plans, calculate and customize plans, compare various plans, solve for financial goals and print reports and forms."- Johnson et al., column 15, lines 17-28

"The system allows the salesperson to edit the amount leased variables including capitalized costs, acquisition fees, insurance fees, lease rates, payment factors, payment schedules, payment methods, security deposits, and taxes and fees to present various lease options"- column 15, lines 50-57

"For each product in the category, a product score is calculated by summing the product of the weights of the responses by the evaluation ratings for that product. The results are displayed, organized into rows and columns in the order of the product scores and weights." Geller et al., abstract |

		Figure 2B, "Product Score", items 262-1 to 262-3 Explanation-Johnson et al. teach presenting financing and leasing options and alternatives to customers. However, Johnson et al. do not specifically recite ordering said options (i.e. hierarchy). Geller et al. state "selecting a product from a number of competing products can be a difficult task"-column 1, lines 20-23. In the context of Johnson et al. the **competing products** are the **financial and leasing options.** Hence, it would have been obvious to one of ordinary skill to rank the **financial and leasing options generated by the modules** of Johnson et al. in order to allow the customer to see which of the possible **plans** best meet the customers **financial goals.**

112 Second Paragraph

Claims 12, 17 and 22 recite "a manual check" of a hierarchy of options.

Appellant's Specification teaches that the options are generated by a computer system

(Specification, page 42, lines 16-19), the "manual check", however is performed by a

person (Specification, page 43, lines 18-21). Therefore, as a person is not part of a

computer system it is unclear to one of ordinary skill the subject matter for which

Appellant is seeking protection.

103 Rejection

Claims 1, 17 and 21

"...a set of predefined conditions"

Appellant is of the opinion that the prior art does not disclose "a set of predefined

conditions". The Examiner respectfully disagrees. Appellant defines "pre-defined

conditions" as either a time or cost variable (Specification, paragraph 114; Appeal Brief,

page 16, section C, 1). For example, Johnson specifically recites a "cost variables" such

as unit price, discounts, fees and taxes (column 14, lines 24-26). Regarding "time

variables", Johnson et al. disclose payment schedules and interest rates which are

dependent on time. In general the Johnson et al. system is directed to providing a

customer with a product analysis "over a time period" that incorporates "both fixed and

variable costs to demonstrate to the customer the overall impact of a purchase decision

including owning costs, operating costs, maintenance costs and depreciation" ('525,

column 16, lines 9-16) and presents to a customer a plurality of leasing options ('525,

column 15, lines 55-57).

"...hierarchy of disposition options"

Appellant is of the opinion that the combined prior art does not disclose a

"hierarchy of dispositions". The Examiner respectfully disagrees. Johnson et al. teach a

salesperson identifying "purchasing and financing options for the product(s) offered to

the customer" ('525, figure 21B) and presenting financing and leasing alternatives ('525,

column 15, lines 17-28). To one of ordinary skill a hierarchy of options is merely a

ranking of alternatives. Further, Johnson et al. also teach a graphic presentation for a

user that displays a side-by-side competitive analysis of cash flow and annual savings

for the use of a product over time, where the competitive analysis is over a time period

and compares financing alternatives (column 16, lines 8-20). Geller et al. teach a

system for displaying options to a user based on rank or preference ('990, abstract;

figure 2B). Therefore, it would have been obvious to one of ordinary skill to combine the

teachings of Johnson et al. and Geller et al. in order to allow the customer to see which

of the possible financial plans best meet the customers financial goals ('525, column 15,

lines 20-25).

Johnson et al. and Geller et al. are incapable of combination

There must be some reason, suggestion, or motivation found in the prior art

whereby a person of ordinary skill in the field of the invention would make the

combination. That knowledge cannot come from the applicant's invention

itself (*In re Oetiker*, 24 USPQ2d 1443 (CAFC 1992)).

Regarding the combination of Johnson et al. with Geller et al., Johnson et al.

teach displaying to a customer a side-by-side competitive analysis of cash flow and

annual savings for the use of a product over time, where the competitive analysis is

over a time period and compares financing alternatives ('525, column 15, lines 23-25;

column 16, lines 8-20), while Geller et al. teach a system for displaying options to a user

based on rank or preference ('990, abstract; figure 2B). More specifically, Geller et al.

disclose that "selecting a product from a number of competing products can be a difficult

task" ('990, column 1, lines 20-23). Although, Geller et al. is directed to purchasing

software, in the context of Johnson et al. the Geller et al. "products" are different

financial plans for purchasing or leasing a product ('525, column 15, lines 17-50; column

16, lines 8-13). Hence, Geller et al. have provided one of ordinary skill using the

Johnson et al. system an improved method for presenting financial plans for purchasing

a car, for example, to a customer, such as one that informs the customer the best plan,

for meeting the customer's financial goals ('525, column 15, lines 20-25; column 16,

lines 21-26).

Claims 3 and 18

Johnson et al. teach presenting to a customer a competitive analysis of different

financial plans for purchasing or leasing a product ('525, column 15, lines 23-25; column

16, lines 8-20). Johnson et al. also teach payment schedule, dates, method, terms and

options ('525, column 15, lines 42-50) and solving a customer's financial goals. To one

of ordinary skill, how much a customer is looking to pay a month for the purchase or

leasing of a product is a financial goal ('525, column 15, lines 20-25). Hence, as what a

user pays monthly is part of a payment schedule, the prior art clearly discloses to one of

ordinary skill presenting a financial plan to a user that matches a customer's desired

monthly payout at the end of beginning, middle and end of a lease term.

Claims 7 and 18

Johnson et al. teach presenting to a customer a competitive analysis of different

financial plans for purchasing or leasing a product ('525, column 16, lines 8-20),

therefore, the prior art at least suggests to one of ordinary skill comparing the cost of

leasing a product with lower cost alternatives ('525, column 15, lines 50-57).
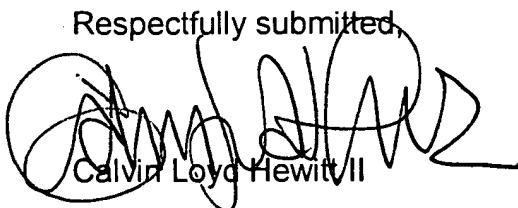
Claims 12, 17 and 22

The system of Johnson et al. allows a salesperson to edit the amount financed, cash down requirements and insurance ('525, column 15, lines 42-50) and presents to a customer a competitive analysis of different financial plans for purchasing or leasing a product ('525, column 16, lines 8-20). Ultimately as a customer accepts or declines a proposed financial plan, the customer provides Appellant's desired "manual check".

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Calvin Loyd Hewitt II

Conferees:

Vincent Millin

Andrew Fischer